

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Inventors: Richard O. Chen, et al.)	Examiner: Lori A. Clow
)	
Application No.: 10/502,420)	Art Unit: 1631
)	
Filed: August 26, 2005)	Confirmation No.: 5778
)	
Title: Drug Discovery Methods)	
)	

ELECTRONICALLY FILED ON: March 3, 2010

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Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PRIORITY OR

ALTERNATIVELY

PETITION UNDER 37 CFR 1.78(a) FOR UNINTENTIONALLY DELAYED BENEFIT

CLAIM

Sir/Madam:

This communication is to request that application number 10/502,420 be granted priority based upon U.S. Provisional Application No. 60/353,176, and U.S. Provisional Application No. 60/421,772.

REMARKS

The priority date should be adjusted for one of two alternative reasons. First, the date should be adjusted because the Office recognized our priority claim. Second, and in the alternative, applicant requests that should the Office deem it necessary, a petition to accept an unintentionally delayed benefit claim be granted. The specification has been amended to reference the provisional applications and any delay making this amendment was unintentional.

I. Adjusting the priority date based on the Office's recognition of the priority documents.

a. Priority information was included on a filing receipt but was mislabeled by the Office.

A first issue is the whether the Office recognized the priority claim made by the applicant on the filing receipt mailed on 10/18/2005. It is important whether the Office recognizes the claim when, as in this application, the applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a). If the Office does recognize the claim then the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim by amending the specification. On the other hand, if the Office does not recognize the claim the applicant must petition under 37 CFR 1.78(a) and pay the surcharge under 37 CFR 1.17(t). The MPEP 201.11 III. D states that (emphasis added):

If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its *inclusion on the filing receipt*. If, however, a claim is not included in the first sentence(s) of the specification or in an ADS and is not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition under 37 CFR 1.78(a) and the surcharge to correct the claim.

Therefore the inclusion of information regarding a claim on a filing receipt is sufficient to satisfy the MPEP's requirements.

Here the applicant contends that the facts demonstrate that the Office did *include* the priority documents on the filing receipt mailed on 10/18/2005. On 6/6/2005 the Office acknowledged the

receipt of the priority documents in form M905. On 8/26/2005 the Office included the priority documents (the US provisional application numbers) on the Bibliographic Data Sheet, although the priority documents were incorrectly labeled by the Office as United Kingdom applications under the Foreign Applications heading. On 10/18/2005 the Office mailed form M903 (the Notice of DO/EO Acceptance) which correctly listed the priority date based upon the US provisional applications and again confirmed the receipt of the priority documents. Also on 10/18/2005 the filing receipt was mailed which *included* the priority documents (the US provisional application numbers), but which again labeled these documents incorrectly as UK applications and listed them under foreign applications. Therefore, the Applicant argues that the filing receipt of 10/18/2005, which included, but mislabeled the US application numbers, satisfies the MPEP's requirement. As a result the applicant should not have to petition and the surcharge should not have to be paid. The first sentence of the specification has been amended and the earlier filing date should be recognized.

b. The Office's error on the filing receipt was corrected and demonstrates that the priority claim was recognized by the Office.

A second issue is whether a corrected filing receipt is sufficient to demonstrate that a priority claim was recognized by the Office. The examiner has argued that only a *first* filing receipt is sufficient. Applicant contends that, according to the MPEP, any filing receipt should suffice.

The MPEP is ambiguous on the issue of whether a corrected filing receipt will suffice to demonstrate that the Office recognizes a priority claim. Specifically, the relevant section of the MPEP refers only to "*the* filing receipt" as opposed to the "*first* filing receipt." MPEP 201.11 III. D states (emphasis added):

If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on *the filing receipt*. If, however, a claim is not included in the first sentence(s) of the specification or in an ADS and is not recognized by the Office as shown by its absence on *the filing receipt*, the Office will require a petition under 37 CFR 1.78(a) and the surcharge to correct the claim.

In this application the Office made an an error on the first filing receipt. The priority documents (the US provisional application numbers), were included on the first filing receipt but, were incorrectly mentioned as United Kingdom applications. The first filing receipt therefore recognized a priority claim but incorrectly identified them as UK applications. Applicant has contended above that this first filing receipt is sufficient to establish a priority claim despite the Office's error. The examiner contends that the Office's error in categorizing the priority documents means that the Office did not include the priority documents on this first filing receipt, and that the applicant must petition and pay a surcharge. In short, the examiner contends that the MPEP requires a proper *first* filing receipt

The filing receipt however has been corrected (please see the 8/24/2009 amended filing receipt), and now reflects the priority information with no associated errors. Applicant argues that because MPEP 201.11 III. D only requires "the filing receipt" to recognize the claim, as opposed to the "first filing receipt", the applicant should not have to petition and the surcharge should not have to be paid. The first sentence of the specification has been amended and the earlier filing date should be recognized.

II. Petition to accept unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 356(c).

In the alternative, if necessary, applicant requests that the Office consider this paper as a petition to accept unintentionally delayed benefit claim and grant such petition.

The reference to the prior application has been previously submitted. Attention is called to the amended specification filed August 20, 2009 and recognized by examiner in final office action mailed on 1/13/2010. Furthermore, attention is called to the corrected filing receipt mailed on 8/24/2009.

The entire delay between the date that the claim was due and the date the claim was filed was unintentional.

CONCLUSION

In the event that the priority date is not adjusted based upon the filing receipt, and the petition to accept the unintentional delay is deemed necessary, the Commissioner is authorized to charge any fees required under 37 CFR 1.17(t) from Deposit account No. 23-2415 (Attorney Docket No. 27763-705.831) or any other fees in connection with this Petition which may be required.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

Dated: March 3, 2010

By:



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